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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,500	07/22/2003	Greet Vanderkimpen	021565-119	1677

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EXAMINER	
COLLINS, CYNTHIA E	
ART UNIT	**PAPER NUMBER**
1638	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,500	VANDERKIMPEN ET AL.	
	Examiner	Art Unit	
	Cynthia Collins	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *July 22, 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-18* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 and 18, drawn to a promoter fragment comprising a nucleotide sequence of SEQ ID NO:2, including SEQ ID NO:1, and a chimeric gene, classified in class 536, subclass 24.1, for example.

II. Claims 1-8 and 18, drawn to a promoter fragment comprising a nucleotide sequence of SEQ ID NO:15, and a chimeric gene, classified in class 435, subclass 320.1, for example.

III. Claims 9-12, drawn to a plant cell, plant and seed comprising a chimeric gene of Group I, classified in class 435, subclass 419, for example.

IV. Claims 9-12, drawn to a plant cell, plant and seed comprising a chimeric gene of Group II, classified in class 800, subclass 298, for example.

V. Claims 13-14, drawn to a method for expressing a biologically active RNA by using the cells of the roots of the plants of Group III, classified in class 800, subclass 287, for example.

VI. Claims 13-14, drawn to a method for expressing a biologically active RNA by using the cells of the roots of the plants of Group IV, classified in class 800, subclass 287, for example.

VII. Claims 15-16, drawn to an isolated DNA molecule encoding SEQ ID NO:4, including SEQ ID NO:3, classified in class 536, subclass 23.6, for example.

VIII. Claims 15-16, drawn to an isolated DNA molecule encoding SEQ ID NO:6, including SEQ ID NO:5, classified in class 536, subclass 23.6, for example.

IX. Claim 16, drawn to an isolated DNA molecule of SEQ ID NO:11, classified in class 536, subclass 23.6, for example.

X. Claim 17, drawn to a method for isolating a promoter region by identifying a genomic fragment encoding a transcript from which a cDNA of SEQ ID NO:3 can be synthesized and isolating a DNA region upstream of a nucleotide sequence encoding SEQ ID NO:4, classified in class 435, subclass 91.1, for example.

XI. Claim 17, drawn to a method for isolating a promoter region by identifying a genomic fragment encoding a transcript from which a cDNA of SEQ ID NO:5 can be synthesized and isolating a DNA region upstream of a nucleotide sequence encoding SEQ ID NO:6, classified in class 435, subclass 91.2, for example.

Applicants are reminded that nucleotide sequences encoding different proteins, and the amino acid sequences they encode, are structurally distinct chemical compounds and are unrelated to one another. Promoter sequences that differ in primary structure are also structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide and amino acid sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a

member of a single genus of invention, but constitutes an independent and patentably distinct invention.

The inventions are distinct, each from the other because of the following reasons:

Invention I and Inventions III-IX and XI are distinct inventions. The promoter fragment and chimeric gene of invention I differ in structure, function and use from plant cell, plant and seed of inventions III-IV and the isolated DNA molecules of inventions VII-IX. The promoter fragment and chimeric gene of invention I are not required to practice or produced by the methods of inventions V-VI and XI.

Inventions I and X are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the promoter fragment can be made by another and materially different process, such as by chemical synthesis.

Invention II and Inventions III-XI are distinct inventions. The promoter fragment and chimeric gene of invention II differ in structure, function and use from plant cell, plant and seed of inventions III-IV and the isolated DNA molecules of inventions VII-IX. The promoter fragment and chimeric gene of invention II are not required to practice or produced by the methods of inventions V-VI and X-XI.

Invention III and Inventions IV and VI-XI are distinct inventions. The plant cell, plant and seed of invention III differ in structure from the plant cell, plant and seed of invention IV.

The plant cell, plant and seed of invention III are not required to practice or produced by the methods of inventions V and X-XI. The plant cell, plant and seed of invention III differ in structure, function and use from the isolated DNA molecules of inventions VII-IX.

Inventions V and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the plant can be used in a materially different process of using that product, such as a breeding method.

Invention IV and Inventions V and VII-XI are distinct inventions. The plant cell, plant and seed of invention IV are not required to practice or produced by the methods of inventions V and X-XI. The plant cell, plant and seed of invention IV differ in structure, function and use from the isolated DNA molecules of inventions VII-IX.

Inventions VI and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the plant can be used in a materially different process of using that product, such as a breeding method.

Invention V and Inventions VI-XI are distinct inventions. The method of invention V utilizes a structurally different material and results in the production of a structurally different product than the method of invention VI. The method of invention V does not require the use of

or result in the production of the isolated DNA molecules of inventions VII-IX. The method of invention V utilizes different materials and method steps and result in the production of different products than the methods of inventions X-XI.

Invention VI and Inventions VII-XI are distinct inventions. The method of invention VI does not require the use of or result in the production of the isolated DNA molecules of inventions VII-IX. The method of invention VI utilizes different materials and method steps and result in the production of different products than the methods of inventions X-XI.

Invention VII and Inventions VIII-XI are distinct inventions. The isolated DNA molecule of invention VII differs in structure from the isolated DNA molecules of inventions VIII and IX, and encodes an amino acid sequence different from the amino acid sequences encoded by the isolated DNA molecules of inventions VIII and IX. The isolated DNA molecule of invention VII is not required to practice or produced by the methods of inventions X and XI.

Invention VIII and Inventions IX-XI are distinct inventions. The isolated DNA molecule of invention VIII differs in structure from the isolated DNA molecule of invention IX, and encodes an amino acid sequence different from the amino acid sequence encoded by the isolated DNA molecule of invention IX. The isolated DNA molecule of invention VIII is not required to practice or produced by the methods of inventions X and XI.

Invention IX and Inventions X-XI are distinct inventions. The isolated DNA molecule of invention IX is not required to practice or produced by the methods of inventions X and XI.

Invention X and Invention XI are distinct inventions. The methods of inventions X and XI utilize structurally different materials and result in the production of structurally different products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to

retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins
Primary Examiner
Art Unit 1638

CC

Cynthia Collins

3/2/06